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PATENT
Attorney Docket No.: 2001-IP-004117 U1D1 USA



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Kevin R. Manke et al.
Serial No.: 10/602,109
Filed: June 23, 2003
Entitled: OPEN HOLE FORMATION TESTING
Group Art Unit: 2856
Examiner: A. Jackson

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is filed in response to the April 19, 2004 Office Action in the above-identified application, which Office Action was indicated as being final.

REMARKS

Reconsideration of this application, in view of the following remarks, is respectfully requested.

The following rejections were set forth in the Office Action:

1. Claims 28, 29, 31 and 32 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,799,733 to Ringgenberg et al.;
2. Claims 28, 29, 31 and 32 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 3,437,138 to Scott;
3. Claims 30 and 33 stand rejected under 35 USC §103 as being obvious over Ringgenberg et al. in view of published European application no. EP 0295922 of Christensen; and
4. Claims 30 and 33 stand rejected under 35 USC §103 as being obvious over Scott in view of Christensen.

Regarding the rejections of independent claim 28 as being anticipated by each of the Ringgenberg and Scott references, these rejections are respectfully traversed. Neither of these references describes the use of a waste chamber. The examiner apparently considers the samplers described in these references as the waste chambers recited in the claims. However, any person of ordinary skill in the art recognizes that a sampler is definitely not the same as a waste chamber. Therefore, since neither of the Ringgenberg and Scott references discloses this element recited in claim 28, these references cannot anticipate the claim, and for this reason the examiner is respectfully requested to withdraw the rejections of claim 28 and its dependents.

In addition, claim 28 recites that the waste chamber is opened in response to pressure in the annulus. Neither of the Ringgenberg and Scott references describes

opening any chamber in response to pressure in the annulus. Ringgenberg describes samplers 52, 136, 234, 308, 348 and 390, some of which may be exposed to pressure in the annulus, but none of the samplers are described as being opened in response to pressure in the annulus. Scott also does not describe opening any chamber in response to pressure in the annulus. Instead, Scott specifically teaches away from using pressure to open his sampler closure device (see col. 1, ll. 63-67 and col. 7, ll. 8-17). Therefore, since neither of the Ringgenberg and Scott references discloses the opening of a waste chamber in response to pressure in the annulus, these references cannot anticipate claim 28, and for this additional reason the examiner is respectfully requested to withdraw the rejections of claim 28 and its dependents.

Regarding the anticipation rejections of claim 31, these rejections are also respectfully traversed. Claim 31 recites a waste chamber in the formation testing apparatus. As discussed above, neither of the Ringgenberg and Scott references discloses a waste chamber in a formation testing apparatus. For this reason, the examiner is respectfully requested to withdraw the rejections of claim 31 and its dependents.

Claim 31 also recites that the waste chamber is opened in response to pressure in the annulus. As discussed above, neither of the Ringgenberg and Scott references discloses a waste chamber opened in response to pressure in the annulus. For this additional reason, the examiner is respectfully requested to withdraw the rejections of claim 31 and its dependents.

Regarding the obviousness rejections of claims 30 and 33, these rejections are also respectfully traversed. A *prima facie* case of obviousness has not been made out, at least in part in that there is no suggestion or motivation expressed in any of these references for making the combination suggested by the examiner. Instead, the examiner has attempted to make the combination based on a piecemeal assembly of the elements recited in the claims, using the applicants' claims as a guide. This uses the

applicants' own claims against them based on impermissible hindsight, which is prohibited by the patent rules (see MPEP §2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."). Therefore, for this reason the examiner is respectfully requested to withdraw the obviousness rejections of claims 30 and 33.

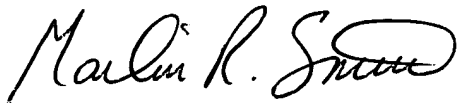
In addition, Christensen specifically and repeatedly teaches away from flowing well fluid into a tool string above a completion packer. Claim 31 recites that fluid flows into the tubular string above the packer. A person skilled in the art would definitely not use the teachings of Christensen to produce the invention of claim 31, since Christensen teaches directly away from the invention of claim 31. Therefore, for this additional reason the examiner is respectfully requested to withdraw the obviousness rejection of claim 31.

In view of the foregoing remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 28-33 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

KONNEKER & SMITH, P.C.



Marlin R. Smith
Attorney for Applicants
Registration No. 38,310

Dated: *June 15, 2004*

660 North Central Expressway
Suite 230
Plano, Texas 75074
(972) 516-0030

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Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450,

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Shen W. Jufko